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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/508,540	04/07/2000	KAZUYA OTSUJI	0327-0836-3	1110
22850	7590	09/11/2003		EXAMINER
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				CHIN, RANDALL E
			ART UNIT	PAPER NUMBER
			1744	

DATE MAILED: 09/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

A9-11

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/508,540	OTSUJI ET AL.
	Examiner Randall Chin	Art Unit 1744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 6-8 and 10-39 is/are pending in the application.
  - 4a) Of the above claim(s) 36-39 is/are withdrawn from consideration.
- 5) Claim(s) 6-8 and 10 is/are allowed.
- 6) Claim(s) 11-13, 18-20, 23-25 and 27-35 is/are rejected.
- 7) Claim(s) 14-17, 21, 22 and 26 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

1. Newly submitted claims 36-39 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 36 sets forth a method of forming a brush, comprising a non-woven fabric and claim 37 sets forth a method of forming a brush, comprising a pulp molded product, each entirely distinct from the brush structure itself.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 36-39 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 11, 18, 20, 24, 25, 28, 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Sadler '054.

The patent to Sadler '054 discloses a brush body 10 formed of paper pulp or pulp block (line 46) and defines a base formed of a single layer and a plurality of projections 13 formed from portions of the base that protrude from portions of the base, and wherein the base has a height towards a center portion that is greater than a height at

the peripheral portion (see tapered edges of base 10 in Fig. 2). As for claims 20 and 24, the pulp includes adhesive (lines 46-49) that serves as a binder. As for claim 25, the recitation "capable of" is not a positive limitation in any patentable sense but merely requires the ability to so perform. The paper pulp itself would thus include some fibers. As for claims 28 and 29, the base 10 includes an "antiseptic or sanitary" chemical which would be medicinal in nature. As for claim 30, protrusions 13 are conical and include a frustum of a cone.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 19, 23, 31, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sadler '054.

As for claim 19, Sadler already teaches that the base 10 is of paper pulp which would include fibers. The claimed range is rather broad and appear to be within the level of one skilled in the art since such dimensions appear to be typical fiber lengths. With respect to claim 23, Sadler also teaches that an adhesive is used. The exact amount used, however, would merely be within the level of one skilled in the art depending on the amount of pulp product used in the manufacturing process. Claims 31 and 32, "protrusions" should read -projections—for consistency. As for claims 31, 32 and 33, the specific dimensional limitations of the projections as well as other structural

characteristics of the projections could well be optimized by one skilled in the art depending on the size of the desired brush.

6. Claims 11, 12, 13, 27, 34 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Walters '720.

As for Walters' device being a "brush," a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, Walters discloses pulp material 214 which makes up part of the "brush". As for claim 27, "wings" or "flaps" are deemed adjustable (col. 4, lines 22-25).

#### ***Allowable Subject Matter***

7. Claims 6-8 and 10 are allowed.

Claims 14-17, 21, 22 and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Christie, Hobelmann, Gillem, Ciesielski, Gray, and Dent are pertinent to various devices including projections.
  
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randall Chin whose telephone number is (703) 308-1613. The examiner can normally be reached on Monday through Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Warden can be reached on (703) 308-2920. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Randall Chin  
Primary Examiner  
Art Unit 1744



R. Chin  
September 4, 2003